

AXEL BURMEISTER ET AL.
USSN 09/636,781

REMARKS

Applicants respectfully request reconsideration and allowance of this application in view of the amendments above and the following comments.

Claims 1-11 are pending. Claims 8-11 are withdrawn from consideration. Amendments have been made to claims 1-3 and 6-7. Claims 1-3 have been amended for clarity. Claims 6 and 7 have been amended in response to the Examiner's rejections under 35 U.S.C. 112, second paragraph. A clean copy of these claims is presented above. A mark-up showing the changes that have been made to these claims using brackets and underlining is attached. It is believed that no new matter has been added.

The Examiner rejected claims 3, 6 and 7 under 35 U.S.C. 112, second paragraph, as being indefinite. With respect to claim 3, the Examiner found the terms "metallocene catalyzed polyolefins" and "synthetic block copolymer rubbers" in claim 3 indefinite. In response, Applicants point out the terms are art-recognized terms wherein 34 patents containing "metallocene catalyzed polyolefins" or "synthetic block copolymer rubbers" was retrieved upon searching the USPTO website database on November 22, 2002. Accordingly, Applicants submit that a person of ordinary skill in the art would understand the terms in view of the specification.

With respect to claims 6 and 7, Applicants have amended these claims to remove

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“particularly” and to provide proper Markush language. For the record, Applicants emphasize that although claims 6 and 7 were amended to overcome this rejection, and, therefore, might be considered to have been amended for a reason substantially related to patentability, a fair reading of the amended claims will reveal that the departures from the previous claims were for clarification purposes only, and that Applicants did not narrow the claims in any material respect. Therefore, Applicants submit that the amended claims are entitled to the full range of equivalents.

In view of the foregoing, Applicants submit that the Examiner would be fully justified to reconsider and to withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is, therefore, earnestly solicited.

The Examiner rejected claims 1, 2 and 5 under 35 U.S.C. 102(b) as being anticipated by Ijichi et al. (U.S. Patent No. 4,021,391). According to the Examiner, Ijichi teaches a pressure-sensitive adhesive comprising a non-thermoplastic elastomer, a polyfunctional isocyanate, and 10-70 parts by weight of a tackifier. In response, Applicants would remind the Examiner that anticipation requires that each and every element as set forth in the claim must be found, either expressly or inherently described, in a single prior art reference, and, further, that the absence in the prior art reference of even a single claim element precludes a finding of anticipation. *In re Robertson*, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). Applicants submit that Ijichi does not

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teach *100 parts by mass* of the non-thermoplastic elastomer. The reference is absent of any teaching of this value for the polymer. Accordingly, Ijichi does not anticipate the rejected claims.

Claims 1-3 and 6 stand rejected under 35 U.S.C. 102(b) as being anticipated by Korpman et al. (U.S. Patent No. 5,760,135). The Examiner found Korpman teaches a pressure-sensitive adhesive composition comprising a mixture of solid and liquid rubber. In response, Applicants submit the reference does not teach the claimed value of *100 parts by mass* for the non-thermoplastic elastomer. Korpman does not teach a pressure-sensitive adhesive composition meeting the terms of the claims, and therefore does not teach the present invention. In fact, the only recited value for the elastomer in the reference is a ratio of solid rubber to liquid rubber by weight. The ratio is recited relative to each other and not representative of the total weight of the combined solid and rubber in the composition.

The Examiner rejected claims 1 and 2 under 35 U.S.C. 102(b) as being anticipated by Kest et al. (U.S. Patent No. 3,932,558). According to the Examiner, Kest teaches a composition comprising a liquid diene telechelic polymer material. In response, Applicants submit that Kest does not teach a pressure-sensitive adhesive composition. It is an *in situ* formation on the substrate, wherein the adhesive composition in the reference is neither a *pressure-sensitive adhesive* nor is it solvent-free. Moreover, the reference does not teach the 100 parts by mass of the non-thermoplastic elastomer as required by the claims. Accordingly, the claims are not

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anticipated by the reference.

The Examiner rejected claims 1 and 2 under 35 U.S.C. 102(b) as being anticipated by JP 58-7471. According to the Examiner, the reference teaches an adhesive composition comprising a liquid rubber, a tackifying resin and a polyisocyanate crosslinking component. In response, Applicants submit the reference does not teach the claimed value of *100 parts by mass* for the non-thermoplastic elastomer. Accordingly, the reference does not anticipate the rejected claims.

Claims 1, 2 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Minatono et al. (U.S. Patent No. 4,204,046). The Examiner found the reference teaches a pressure-sensitive adhesive composition comprising a liquid rubber. In response, Applicants submit the reference does not teach the claimed value of *100 parts by mass* for the non-thermoplastic elastomer. Accordingly, the reference does not anticipate the rejected claims.

In view of the foregoing, Applicants submit that the Examiner would be fully justified to reconsider and to withdraw these rejections. An early notice that these rejections have been reconsidered and withdrawn is, therefore, earnestly solicited.

The Examiner rejected claim 7 under 35 U.S.C. 103(a) as being obvious over Korpman et al. (U.S. Patent No. 5,760,135) in view of Chiang et al. (U.S. Patent No. 3,956,223). According

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to the Examiner, Korpman does not teach the specific plasticizing oils but the Examiner found oils to be contemplated. The Examiner found Chiang to show naphthenic process oils to be useful for building up the softness of the tack and to adjust flow properties and plasticity of pressure sensitive adhesives. The Examiner ultimately found it would have been obvious to modify the adhesive composition of Korpman by using the oils contemplated in Chiang to obtain the present invention. In response, Applicants submit that a person of ordinary skill in the art would not obtain the present invention because Chiang contemplates using the oils with thermoplastic block copolymers. See col. 4, lines 41-43. The Examiner proposes to use the oils contemplated in Chiang for use in the composition of Korpman. However, Korpman contemplates a composition with both solid and liquid rubbers as well as a thermoplastic component. See Abstract. Applicants point out the selection of oils in the present invention requires the adhesive composition to be based upon *non-thermoplastic* elastomers. There is nothing in the combination to suggest such use in connection with non-thermoplastic elastomers. Accordingly, because the Examiner is required to show the references to teach or suggest all the claim limitations, the claim is not rendered obvious. See *MPEP* §2143.

The Examiner rejected claims 1, 2 and 5 under 35 U.S.C. 103(a) as being obvious over Arend et al. (U.S. Patent No. 5,204,409) in view of Ijichi et al. According to the Examiner, Arend teaches the use of polyisocyanates as cross-linking agents for polymeric adhesives selected from the group consisting of natural and synthetic rubbers, polybutadienes or polyisoprenes. The


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Examiner found Ijichi teaches 10-70 parts by weight of tackifiers. The Examiner ultimately found it would have been obvious to incorporate the tackifiers of Ijichi into the composition of Arend to obtain the present invention. In addition, the Examiner found it would have been obvious to use a catalyst to accelerate the cross-linking because it is taught in the prior art.

In response, Applicants point out that a combination of the references would not have led a person skilled in the art to the present invention since one reference contemplates adhesives in the presence (Arend reference) of a solvent and the other in the absence (Ijichi reference) of a solvent. Ijichi's tackifiers are selected in the context of a solvent-free composition. The Examiner has not shown in the cited combination of references a suggestion that such solvent-free compatible tackifiers should be used in Arend's fundamentally different solvent-based composition with a reasonable expectation of success. In the absence of either the suggestion or the reasonable expectation of success, Applicants submit that the rejected claims are not *prima facie* obvious over the cited combination of references.

X Claims 1-3, 5 and 6 are rejected under 35 U.S.C. 103(a) as being obvious in view of Lawrence (U.S. Patent No. 3,860,673). According to the Examiner, the reference discloses an elastomeric composition, useful as an adhesive, comprising a synthetic or naturally occurring elasomer, an organic polyisocyanate, and a catalyst. In response, Applicants submit that a person of ordinary skill in the art would not obtain the present invention because the reference

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contemplates an adhesive that is not solvent-free. Specifically, the reference preferably employs an elastomer as a solution in an organic solvent. See col. 1, lines 65-66. Because the present claims require the adhesive to a hot-melt (or solvent-free) adhesive, the claims are not rendered obvious by the cited reference. ✓ 

In view of the foregoing, Applicants submit that the Examiner would be fully justified to reconsider and to withdraw these rejections. An early notice that these rejections have been reconsidered and withdrawn is, therefore, earnestly solicited.

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

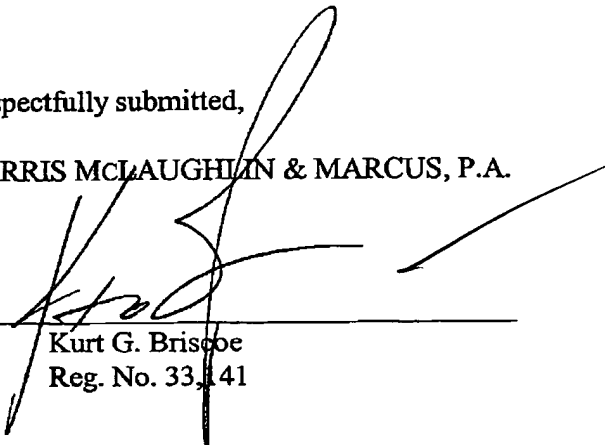
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Early and favorable action is earnestly solicited.

Respectfully submitted,

NORRIS McLAUGHLIN & MARCUS, P.A.

By


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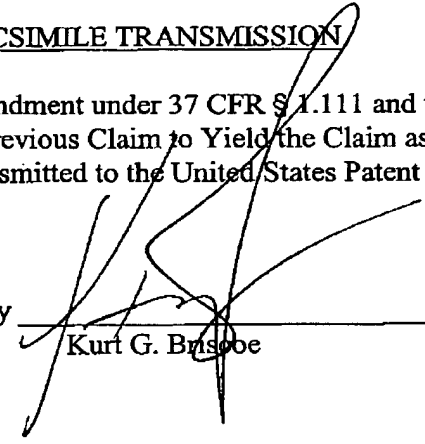
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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment under 37 CFR § 1.111 and the attached Mark-Up Showing the Changes Made in the Previous Claim to Yield the Claim as Amended Above (13 pages total) are being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: November 25, 2002

By


Kurt G. Briscoe

MARK-UP SHOWING THE CHANGES MADE IN THE PREVIOUS CLAIM TO YIELD THE CLAIM AS AMENDED ABOVE

1. (Amended Once) Hot-melt pressure-sensitive adhesive based on at least one [one or more] non-thermoplastic [elastomers] elastomer, the adhesive [at least] comprising 100 parts by mass of the non-thermoplastic [elastomer(s)] elastomer, [from] 1 to 200 parts by mass of [one or more] at least tackifying resin, [resin,] and [also] [one or more] at least one polyfunctional [isocyanates] isocyanate which [are] is free from a blocking agent, the [hot-melt pressure-sensitive] adhesive comprising from 8 mmol to 5 mol of [the] reactive isocyanate groups of the isocyanate per kilogram of the non-thermoplastic [elastomer(s) used] elastomer.

2. (Amended Twice) Hot-melt pressure-sensitive adhesive according to claim 1, wherein the non-thermoplastic [elastomers are] elastomer is selected from the group consisting of natural rubbers, random-copolymerized styrene-butadiene rubbers [(SBR)], butadiene rubbers [(BR)], synthetic polyisoprenes [(IR)], butyl rubbers [(IIR)], halogenated butyl rubbers [(XIIR)], ethylene-vinyl acetate copolymers [(EVA)] and polyurethanes.

3. (Amended Twice) Hot-melt pressure-sensitive adhesive according to claim [2] 1, wherein the adhesive further comprises a polymer blend of [one or more of the] at least one non-thermoplastic [elastomers] elastomer and [one or more] at least one thermoplastic [elastomers] elastomer, wherein said thermoplastic elastomer is selected from the group

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consisting of polypropylenes, polyethylenes, metallocene-catalysed polyolefins, polyesters, polystyrenes and synthetic block copolymer rubbers.

6. (Amended Twice) Hot-melt pressure-sensitive adhesive according to claim 1, wherein fillers are added to the adhesive which are selected [in particular] from the group consisting of metal oxides, chalks, precipitated silicas, [or] pyrogenic silicas, solid glass beads, [or] hollow glass beads, microballoons, carbon blacks, [and/or] glass fibres [or] and polymer fibres.

7. (Amended Twice) Hot-melt pressure-sensitive adhesive according to claim 1 wherein plasticizers are added to the adhesive which are selected [in particular] from the group consisting of paraffinic oils, [or] naphthenic oils, oligomeric nitrile rubbers, liquid isoprene rubbers, oligobutadienes, soft resins, wool fats, [and/or] rapeseed oils and castor oils.